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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,197	04/08/2004	Yurika Kadoi	00862.023534.	7426

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EXAMINER	
PACHOL, NICHOLAS C	
ART UNIT	PAPER NUMBER
2625	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/820,197	KADOI ET AL.	
	Examiner	Art Unit	
	Nicholas C. Pachol	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4 and 8-18* is/are rejected.

7)☒ Claim(s) *5-7* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *09/09/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a certified English translation of the foreign application must be submitted in reply to this action. 37 CFR 41.154(b) and 41.202(e).

Failure to provide a certified translation may result in no benefit being accorded for the non-English application.

Specification

2. The disclosure is objected to because of the following informalities: On page 16, line 20, an open parenthesis is provided with no corresponding close parenthesis.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-18 are rejected under 35 U.S.C. 101 because 101 because the claimed invention is directed to non-statutory subject matter.

Claims 11-18 claim "a computer program product that includes a medium ..." However, the claims do not define a *program product* to be a functional descriptive material encoded on a memory/disk/computer-readable medium, and is thus non-

statutory for that reason, (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized"). Moreover, a "program product" is neither a process ("action"), nor machine, nor manufacture, nor composition of matter (i.e., tangible "thing") and therefore non-statutory. The claims also do not define what is meant by a medium. The medium should explicitly refer to computer-readable medium.

Such claimed "program product that includes a medium" does not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program' s functionality to be realized. As such, "program product", not claimed as embodied/encoded in computer-readable medium and is not statutory because the "program product" is not capable of causing functional change in the computer. Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory and appears to be one type of claim that is considered nonstatutory, under the present USPTO Interim Guidelines, 1300 Official Gazette Patent and Trademark Office 142 (Nov. 22, 2005).

The Examiner suggests amending the claim to include the disclosed tangible computer readable media, while at the same time ***excluding*** the intangible media such as signals, carrier waves, etc...

Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4, 8-14, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimizu (US 2004/0205641).

Regarding Claim 1, Shimizu teaches an information processing apparatus for implementing a print preview display of print data that is to be printed (Page 1, paragraph 10), comprising:

an acquisition unit for acquiring amount of offset of a page in a print preview (Page 4, paragraph 57);

a preview image generating unit for generating a print preview image of the print data (Page 4, paragraph 57); and

a preview display control unit for causing the preview image display, which is generated by said preview image generating unit, to be offset and displayed for every sheet of paper in a case where the print data is to be printed on a plurality of sheets of

paper, based upon amount of offset acquired by said acquisition unit (Page 4, paragraphs 63 and 70).

Regarding Claim 2, Shimizu further teaches an offset-amount input unit for inputting amount of offset of the print preview based upon a designation from a user (Figure 4, and Page 4, paragraph 56);

wherein said acquisition unit acquires the amount of offset that has been input from said offset-amount input unit (Page 4, paragraph 57).

Regarding Claim 3, Shimizu further teaches wherein said offset-amount input unit is capable of specifying direction and is capable of inputting independent amounts of offset in vertical and horizontal directions (Figure 9 and Page 5, paragraphs 74-76).

Regarding Claim 4, Shimizu further teaches wherein said acquisition unit selects and acquires an amount of offset, which is larger than size of a margin that has been set for the print preview image, from amounts of offset that have been stored by a management unit that is capable of storing a plurality of offset amounts (Page 4, paragraph 56, wherein the default is to show only the top sheet, and Pages 5 and , paragraph 89).

Regarding Claim 8, Shimizu teaches an information processing apparatus for implementing a print preview display of print data that is to be printed (Page 1, paragraph 10), comprising:

an image creating unit for creating preview images obtained by superimposing images of sheets of paper, on which the print data is to be printed, upon offsetting the images of the sheets of paper by a specified amount of offset (Page 4, paragraphs 56 and 57); and

a display unit for displaying the preview images created by said image creating unit (Page 4, paragraph 56).

Regarding Claim 9, Shimizu teaches a print preview display method for presenting a print preview display of print data that is to be printed (Page 1, paragraph 10), comprising:

an acquisition step of acquiring amount of offset of a page in a print preview (Page 4, paragraph 56);

a preview image generating step of generating a print preview image of the print data (Page 4, paragraph 63) ; and

a preview display control method of causing the preview image display, which is generated at said preview image generating step, to be offset and displayed for every sheet of paper in a case where the print data is to be printed on a plurality of sheets of paper, based upon amount of offset acquired at said acquisition step (Page 4, paragraph 65).

Regarding Claim 10, Shimizu teaches a print preview display method for presenting a print preview display of print data that is to be printed (Page 1, paragraph 10), comprising:

an image creating step of creating preview images obtained by superimposing images of sheets of paper, on which the print data is to be printed, upon offsetting the images of the sheets of paper by a specified amount of offset (Page 4, paragraphs 56 and 57); and

a display step of displaying the preview images created at said image creating step (Page 4, paragraph 63).

Regarding Claim 11, Shimizu teaches a computer program product that includes a medium on which has been encoded a program for causing a computer to implement a preview display of print data to be printed (Page 7, paragraph 116), said program having:

code of an acquisition step of acquiring amount of offset of a page in a print preview (Page 4, paragraph 57);

code of a preview image generating step of generating a print preview image of the print data (Page 4, paragraph 57); and

code of a preview display control method of causing the preview image display, which is generated at said preview image generating step, to be offset and displayed for every sheet of paper in a case where the print data is to be printed on a plurality of

sheets of paper, based upon amount of offset acquired at said acquisition step (Page 4, paragraphs 63 and 70).

Regarding Claim 12, Shimizu further teaches said program further having code of an offset- amount input step of inputting amount of offset of the print preview based upon a designation from a user (Figure 4 and Page 4, paragraph 56);

wherein said acquisition step acquires the amount of offset that has been input at said offset-amount input step (Paged 4, paragraph 57).

Regarding Claim 13, Shimizu further teaches wherein said offset-amount input step is capable of specifying direction and is capable of inputting independent amounts of offset in vertical and horizontal directions (Figure 9 and Page 5, paragraphs 74 and 76).

Regarding Claim 14, Shimizu further teaches wherein said acquisition step selects and acquires an amount of offset, which is larger than size of a margin that has been set for the print preview image, from amounts of offset that have been stored by a management unit that is capable of storing a plurality of offset amounts (Page 4, paragraph 56, wherein the default is to show only the top sheet, and Page 5, paragraph 89).

Regarding Claim 18, Shimizu teaches a computer program product that includes a medium on which has been encoded a program for causing a computer to present a print preview display of print data that is to be printed (Page 7, paragraph 116), said program having:

code of an image creating step of creating preview images obtained by superimposing images of sheets of paper, on which the print data is to be printed, upon offsetting the images of the sheets of paper by a specified amount of offset (Page 4, paragraphs 56 and 57); and

code a display step of displaying the preview images created at said image creating step (Page 4, paragraph 56).

Allowable Subject Matter

6. Claims 5-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 5 is allowable because the prior art fails to teach a specifying unit for specifying whether to select an amount of offset that has been input by said offset-amount input unit or to select an amount of offset that has been stored by said management unit.

Claim 6 is allowable because the prior art fails to teach wherein said preview display control unit selects an appropriate amount of offset from a plurality of offset amounts, which are stored by said management unit, based upon the print layout, and

causes the print preview image to be offset and displayed page by page based upon the amount of offset selected.

Claim 7 is allowable because the prior art fails to teach wherein the print layout set by said print setting unit includes a borderless print setting; and

if borderless printing has been set, said preview display control unit selects from said management unit an amount of offset that is less than that in a case where borderless printing is not set.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas C. Pachol whose telephone number is 571-270-3433. The examiner can normally be reached on M-T, 7:00 a.m.-5:30 p.m. (EST), Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

N.P.
02/13/08

/Nicholas C Pachol/
Examiner, Art Unit 2625

/Twyler L. Haskins/
Supervisory Patent Examiner, Art Unit 2625
3/15/08